

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1, 2, 4, 6-8, 13-14, 23, 25-27, and 30 are currently pending. Claims 15-22 have been cancelled and claims 3, 5, 9-12, 24, and 28-29 are withdrawn from consideration. It is submitted that the withdrawn claims should be reconsidered and reintroduced into the application when the independent claims from which they depend are found allowable.

Claim 1 has been amended in this response. No new matter has been introduced by this amendment. It is submitted that these claims were patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The changes to the claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §102(b) HAVE BEEN OVERCOME

Claims 1, 2, 4, 6-8, 13-14, 23, 25-27, and 30 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,498,468 to Blaney.

Independent claims 1 and 23 define a hydroentangling device used in combination with a support fabric that is comprised of flattened filaments and is usable for the production of hydroentangled nonwoven product. The support fabric is not part of the final hydroentangled nonwoven product. For example, as can be seen in Figure 8 of the present application, the support fabric 38 acts as the conveyor belt in a hydroentangling device. Fibers are deposited on the support fabric and undergo hydroentanglement in order to form a hydroentangled nonwoven fabric, which is subsequently removed from the support fabric for further processing.

In order to clarify the scope of the current claims, independent claim 1 has been amended to recite as follows:

“A hydroentangling device in combination with a hydroentangling support fabric comprising flattened filaments usable for the production of a hydroentangled nonwoven product, said hydroentangled nonwoven product being formed on and thereafter removed from said support fabric.” (emphasis added)

As understood by the Applicants, Blaney relates to a method of making a flexible fabric composed of a fibrous matrix of ribbon-like, conjugate, spun filaments, which includes the following steps providing a fibrous matrix composed of individual, spun filaments bonded at spaced-apart bond locations and applying a flattening force to the fibrous matrix to durably distort the core of individual filaments into a ribbon-like configuration having a width greater than its height. The flattening force therein is applied by using pressure and temperature, such as a calender roll arrangement. *Blaney*, col. 5, lines 16-19.

Though Blaney teaches the use of high-pressure liquid water jets in order to carry out mechanical softening of the nonwoven fabric produced, it however does not teach or suggest the use of a support fabric comprising flat monofilaments. The flattening force in Blaney is applied by using pressure and temperature, such as a calender roll arrangement and nowhere in its

disclosure does Blaney teach or suggest the use of a support fabric comprising flattened filaments, as recited in independent claim 1.

In order for a claim to be anticipated by prior art under § 102, the prior art must disclose each and every element of the claim. Blaney, however, does not teach or disclose the above identified feature of claim 1. Therefore, Applicants respectfully submit that independent claim 1 is patentable over Blaney. For reasons similar to the ones discussed above, independent claim 23 is also believed to be patentable.

Dependent claims 2, 4, 6-8, 13-14, 25-27, and 30 depend from either claim 1 or claim 23, as discussed above, and are similarly patentable over Blaney.

III. REJECTIONS UNDER 35 U.S.C. §103(a) HAVE BEEN OVERCOME

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as unpatentable over Blaney. Additionally, the Examiner rejected claims 1-2, 4, 6, 23, and 25-27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,110,905 to Rhodes, in view of, U.S. Patent No. 6,060,145 to Smith.

As understood by the Applicants, Rhodes relates to a soft floor covering such as a tufted pile fabric produced on a tufting machine. Smith relates to a method of manufacture of a carpet. Specifically, a secondary backing fabric for use in a carpet, comprising a secondary backing scrim fabric and a fiber batt integrated with the secondary backing fabric. There is no teaching or suggestion in either Rhode or Smith for the use of a support fabric comprising flattened yarns in a hydroentangling device, as recited in independent claim 1. In the Advisory action, the Examiner contends that it would have been obvious to one having ordinary skill in the art at the time of invention to combine the tufted fabric of Rhodes with a hydroentangling device to

produce the desired secondary backing material. Applicants respectfully disagree. Applicants would like to underscore the fact that the claimed invention is a hydroentangling device in combination with a hydroentangling support fabric comprising flattened filaments usable for the production of a hydroentangled nonwoven product, wherein the hydroentangled nonwoven product is being formed on and thereof removed from the support fabric. The instant invention is not directed to a tufted fabric or a secondary backing material for use in a carpet.

Furthermore, a tufted fabric, as is disclosed in Rhodes, and seen in Figures 3-5 therein, includes a great deal of open space due to the tufting of the fabric. Were the fabric of Rhodes to be used as a support fabric in a hydroentanglement device as claimed in independent claims 1 and 23 of the present application, the high-pressure water used to entangle fibers lying on the fabric would likely cause the fibers to entangle not only with themselves but with the tufted fabric, preventing separation of the final hydroentangled product from the tufted support fabric.

Finally, the Examiner rejected claims 1-2, 4, 6-8, 13, 23, and 25-27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,142,752 to Greenway, in view of U.S. Patent No. 4,345,730 to Leuvelink. These rejections are traversed at least for the following reasons.

The Examiner stated that Greenway discloses a hydroentanglement device in combination with a conveyor belt. The Examiner conceded that Greenway does not disclose specific fabric used as a conveyor belt or as a hydroentanglement support fabric. Specifically, Greenway does not teach or suggest the use of a support fabric formed of flattened filaments in its disclosure. In other words, there is no teaching or suggestion in Greenway nor is there a need that Greenway expresses or discloses for the use of a support fabric formed of flattened filaments in its hydroentanglement process. Nor does Leuvelink teach or disclose the use of its belt in a hydroentangling device for the production of a hydroentangled nonwoven product. Therefore,

there is no motivation for one skilled in the art at the time of the invention to modify the teachings of Greenway in view of Leuvelink in order to derive the instant invention.

In the Final Office Action, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to combine these references in order to derive the instant invention. Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P.

§ 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant's disclosure to determine that an Applicants' invention is obvious in view of the cited art. M.P.E.P.

§ 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is nothing that would motivate a skilled worker in the art to modify Matthews in view of all the other references.

It is well established that when a rejection depends on a combination of references, there must be some teaching, suggestion or motivation to combine the references. *See In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed.Cir.1998). To prevent the use of hindsight, the examiner is required to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *Id*

at 1357. Further, in *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (January 27, 2000), *reh'g en banc denied* (March 6, 2000), *cert. denied*, 120 S. Ct. 2679 (U.S. 2000), it was held that:

“Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘clear and particular.’” (emphasis added).

Additionally, Applicants submit that the Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicants' disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, the cited references cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicants' disclosure as a model for the needed changes.

Furthermore, even if the Examiner has located all the limitations of the claimed present invention, which Applicants respectfully disagree, still a fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art.

Hartness International, Inc. v. Simplimatic Engineering Co., 819 F.2d 100, 2 U.S.P.Q.2d 1826

(Fed. Cir. 1987). Applicants respectfully point out that the Examiner has established a pattern of allegedly locating each element of the invention in the prior art and then combining the references to formulate the obviousness rejections.

For at least this reason of reconstruction based on impermissible hindsight, claim 1 should be allowed. For similar reasons independent claim 23 is also allowable.

Dependent claims 2, 4, 6-8, 13-14, 25-27, and 30 depend from either claim 1 or claim 23, as discussed above, and are similarly patentable over the combination of Greenway and Leuvelink.

In the event that the Examiner disagrees with any of the foregoing comments concerning the disclosures in the cited prior art, it is requested that the Examiner indicate where in the reference, there is the basis for a contrary view.

The Examiner has apparently made of record, but not applied, several documents. The Applicants appreciate the Examiner's implicit finding that these documents, whether considered alone or in combination with others, do not render the claims of the present application unpatentable.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

If any issues remain, or if the Examiner has any further suggestions, the Examiner is invited to call the undersigned at the telephone number provided below. The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 

Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800